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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/796,067	03/10/2004	Thomas M. Demartini	111325-370200	2653
22204	7590	05/12/2009	EXAMINER	
NIXON PEABODY, LLP			KAMAL, SHAHID	
401 9TH STREET, NW				
SUITE 900			ART UNIT	PAPER NUMBER
WASHINGTON, DC 20004-2128			3621	
			MAIL DATE	DELIVERY MODE
			05/12/2009	PAPER

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**BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES**

Application Number: 10/796,067

Filing Date: March 10, 2004

Appellant(s): DEMARTINI ET AL.

Joseph A. Parisi (Reg. # 53,435)
For Appellant

EXAMINER'S ANSWER

This is in response to the appeal brief filed February 09, 2009 appealing from the Office action mailed October 17, 2008.

(1) Real Party in Interest

A statement identifying by name the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

The examiner is not aware of any related appeals, interferences, or judicial proceedings which will directly affect or be directly affected by or have a bearing on the Board's decision in the pending appeal.

(3) Status of Claims

The statement of the status of claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Claimed Subject Matter

The summary of claimed subject matter contained in the brief is correct.

(6) Grounds of Rejection to be Reviewed on Appeal

The appellant's statement of the grounds of rejection to be reviewed on appeal is correct.

(7) Claims Appendix

The copy of the appealed claims contained in the Appendix to the brief is correct.

(8) Evidence Relied Upon

7,206,765

Gilliam et al.

05-2001

(9) Grounds of Rejection

The following ground(s) of rejection are applicable to the appealed claims:

Claim Rejections- 35 U.S.C § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

2. Claim 1 is being rejected under 35 U.S.C. §101 because the claimed invention is directed to non-statutory subject matter.

3. Based on Supreme Court precedent (*Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876)) and recent Federal Circuit decisions, §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing (the Supreme Court recognized that this test is not necessarily fixed or permanent and may evolve with technological advances. *Gottschalk v. Benson*, 409 U.S. 63, 71 (1972)).

4. If neither of these requirements is met by the claim(s), the method is not a patent eligible process under 35 U.S.C. §101.

5. In this particular case, regarding the first test, in performing the steps of the claimed subject matter, there is no requirement that a machine be used, thus the claims

are not considered sufficiently tied to another statutory class. Regarding the second test, since the claimed subject matter may be performed using only human intelligence, the steps do not sufficiently transform the underlying subject matter to be statutory.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

7. Claims 1, 3-11, 13-23 and 25-33 are rejected under 35 U.S.C. 102(e) as anticipated by Gilliam et al. (US Patent No. 7,206,765 B2) (“Gilliam”).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference, it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention “by another,” or by an appropriate showing under 37 CFR 1.131.

Referring to claim 1, Gilliam discloses a method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance

with the rights expression, said method comprising:

- a) specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)];
- b) generating a template of said rights expression information, including removing said value for said variable from said element [see at least column 9, lines 6-22, col. 11, lines 6-11 – the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value];
- c) generating an identification for said template [see fig. 1& fig. 3 with associated text]; and
- d) transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template, whereby said rights expression information can be enforced on a device based on said variable and said identification for said template [see abstract & claim 1].

Referring to claim 3, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said template in a predetermined order and situationally determining untransmitted variables

[see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 4, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said template in a non-predetermined order and situationally determining untransmitted variables [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 5, Gilliam discloses a method for creating a rights expression for association with an item for use in a system for controlling use of the item in accordance with the rights expression, said method comprising:

- a) specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)];
- b) generating a template of said rights expression information, including removing said value for said variable from said element [see at least column 9, lines 6-22, col. 11, lines 6-11 – the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value];

- c) generating an identification for said template [see fig. 1& fig. 3 with associated text];
- d) transmitting said identification for said template along with machine- interpretable reconstruction instructions to a device, wherein said device is adapted to follow said machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights];
- e) whereby said rights expression information can be enforced on a device based on said variable and said identification for said template [see abstract & claim 1].

Referring to claim 6, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said template in a predetermined order and determining untransmitted variables according to said machine-interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 7, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said template in a non-predetermined order and determining the untransmitted variables according to said machine-interpretable reconstruction instructions [see at least column

9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights].

Referring to claim 8, Gilliam further discloses transmitting said identification for said template to a device adapted to follow machine-interpretable reconstruction instructions to determine said variable and enforce said rights expression information based on said variable and said identification for said template [see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights].

Referring to claim 9, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said template in a predetermined order, determining the machine-interpretable reconstruction instructions associated with said template, and determining untransmitted variables according to said machine-interpretable reconstruction instructions [see at least column 9, lines 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights].

Referring to claim 10, Gilliam further discloses wherein said transmitting step comprises: transmitting one or more variables associated with said identification for said template in a non-predetermined order, determining the machine-interpretable reconstruction instructions associated with said template, and determining the

untransmitted variables according to said machine-interpretable reconstruction instructions see at least column 9, lines 16-45 – the user makes a request from the vendor is receives the ticket item, which includes rights].

Referring to claims 11, 13-22 are rejected on the same rationale as claims 1-10 above.

Referring to claims 23, 25-33 are rejected on the same rationale as claims 1-10 above.

(10) Response to Argument

Applicants' argue:

"Gilliam does not include all of the elements of claim 1" (pages 8-18, claim 1). Specially, specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable; generating a template of said rights expression information, including removing said value for said variable from said element; generating an identification for said template; and transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template, whereby said rights expression information can be enforced on a device based on said variable and said identification for said template (pages 8-18, claim 1)".

Examiner's response:

Gilliam teaches “specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable (pages 8-18, claim 1) [see at least column 7, lines 11-23, column 8, lines 1-9, column 23, lines 34-47, column 26, lines 2-15 (the file and at least one response with private keying material that it can access)]; generating a template of said rights expression information, including removing said value for said variable from said element (pages 8-18, claim 1) [see at least column 9, lines 6-22, col. 11, lines 6-11 – the rights can be in the form of a profile; col. 7, lines 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value]; generating an identification for said template (pages 8-18, claim 1) [see fig. 1& fig. 3 with associated text]; and transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template, whereby said rights expression information can be enforced on a device based on said variable and said identification for said template (pages 8-18, claim 1) [see abstract & claim 1]. Even if Gilliam did not teach these limitations, it is the Examiner’s position these are functional limitations and as per MPEP 2114, “[A]pparatus claims cover what a device is, not what a device does.” Therefore, these limitations should be given less weight.

As to the claimed features of the independent claims, the elements can be found as outline in the table at the end of this document.

(11) Related Proceeding(s) Appendix

No decision rendered by a court or the Board is identified by the examiner in the Related Appeals and Interferences section of this examiner's answer.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,

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Examiner, Art Unit 3621

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Claim Limitations	Prior Art Reference
Claim 1	Gilliam et al. (US Patent. No. 7,206,765 B2)
specifying rights expression information indicating a manner of use of an item, said rights expression information including at least one element, said element having a variable and corresponding value for said variable.	[see C 7, L 11-23, C 8, L 1-9, C 23, L 34-47, C 26, L 2-15 (the file and at least one response with private keying material that it can access)]
generating a template of said rights expression information, including removing said value for said variable from said element.	[see C 9, L 6-22, C 11, L 6-11 – the rights can be in the form of a profile; C 7, L 39-55 – each time the usage rights is exercised, the value of the state variable can be incremented, which is interpreted as removing the value]
generating an identification for said template	[see fig. 1& fig. 3 with associated text]
transmitting said identification for said template to a device adapted to situationally determine said variable and enforce said rights expression information based on said variable and said identification for said template, whereby said rights expression information can be enforced on a device based on said variable and said identification for said template	[see C 9, L 16-45 – the user makes a request from the vendor and receives the ticket item, which includes rights], [see abstract & claim 1]